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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/526,031	03/15/2000	Jonathan J. Hull	74451.P114	9293

7590 03/29/2004

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EXAMINER

SMITH, PETER J

ART UNIT	PAPER NUMBER
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2176

8

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/526,031

Applicant(s)

HULL ET AL.

Examiner

Peter J Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-17,19-29,31-41 and 43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-17,19-29,31-41 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

1. This action is responsive to communications: application filed on 03/16/2000, IDS filed on 12/17/2000.
2. Claims 1-5, 7-17, 19-29, 31-41, and 43 are pending in the case. Claims 1, 13, 25, and 37 are independent claims.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-5, 7-10, 13-17, 19-22, 25-29, 31-34, and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Covington et al. (hereafter referred to as Covington), US 5,524,193 published 6/4/1996 in view of Gormish et al. (hereafter referred to as Gormish), US 5,337,362 published 8/9/1994 and Russell et al. (hereafter referred to as Russell), US 5,905,248 published 5/18/1999.**

**Regarding independent claim 1**, Covington teaches creating a multimedia annotation for a document and combining the document with the multimedia annotation representing at least one of an audio sound and a video clip to form a multimedia document in col. 2 lines 39-41. What Covington does not teach is that the annotated document may be paper. Gormish does teach adding digital data into a paper document in col. 2 lines 8-40 and col. 3 lines 7-25.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gormish into Covington to create the claimed invention. It would have been obvious and desirable to use the ability to place digitally encoded data onto a paper document taught by Gormish and use the said ability to implement the annotation method of Covington so that the user could have had increased freedom to read the document in either paper form or electronic form.

Covington does not teach that a multimedia document is generated as part of reproducing the paper document via a document reproduction system. Russell does teach that a multimedia document is generated as part of reproducing the paper document via a document reproduction system in fig. 1, 1A, the abstract and col. 3 lines 50-54. Russell integrates embedded hyperlinks pointing to internet resources, which could be audio or video clips, into a paper document. It would have been obvious to have combined Russell and Gormish into Covington to have created the claimed invention. It would have been obvious to have used Russell to have taught one of ordinary skill in the art at the time of the invention how to have created a paper instance of the multimedia annotated document created by Covington. Gormish would have additionally taught one of ordinary skill in the art at the time of the invention how <sup>to</sup> encode different kinds of digital communications other than URLs which could have then been embedded into the multimedia annotated document and then produced a paper instance.

**Regarding independent claim 13,** Covington teaches creating a multimedia annotation for a document and combining the document with the multimedia annotation representing at least one of an audio sound and a video clip to form a multimedia document in col. 2 lines 39-41.

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What Covington does not teach is that the annotated document may be paper. Gormish does teach adding digital data into a paper document in col. 2 lines 8-40 and col. 3 lines 7-25.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gormish into Covington to create the claimed invention. It would have been obvious and desirable to use the ability to place digitally encoded data onto a paper document taught by Gormish and use the said ability to implement the annotation program on machine-readable medium of Covington so that the user could have had increased freedom to read the document in either paper form or electronic form.

Covington does not teach that a multimedia document is generated as part of reproducing the paper document via a document reproduction system. Russell does teach that a multimedia document is generated as part of reproducing the paper document via a document reproduction system in fig. 1, 1A, the abstract and col. 3 lines 50-54. Russell integrates embedded hyperlinks pointing to internet resources, which could be audio or video clips, into a paper document. It would have been obvious to have combined Russell and Gormish into Covington to have created the claimed invention. It would have been obvious to have used Russell to have taught one of ordinary skill in the art at the time of the invention how to have created a paper instance of the multimedia annotated document created by Covington. Gormish would have additionally taught one of ordinary skill in the art at the time of the invention how <sup>to</sup> encode different kinds of digital communications other than URLs which could have then been embedded into the multimedia annotated document and then produced a paper instance.

**Regarding independent claim 25**, Covington teaches a computer system comprising a data storage device, a processor coupled to the storage device, and inherently comprising a bus in

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col. 3 line 63 – col. 4 line 20. Covington also teaches creating a multimedia annotation for a document and combining the document with the multimedia annotation representing at least one of an audio sound and a video clip to form a multimedia document in col. 2 lines 39-41. What Covington does not teach is that the annotated document may be paper. Gormish does teach adding digital data, which could be annotations, into a paper document in col. 2 lines 8-40 and col. 3 lines 7-25.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gormish into Covington to create the claimed invention. It would have been obvious and desirable to use the ability to place digitally encoded data onto a paper document taught by Gormish and use the said ability to implement the annotation computer system of Covington so that the user could have had increased freedom to read the document in either paper form or electronic form.

Covington does not teach that a multimedia document is generated as part of reproducing the paper document via a document reproduction system. Russell does teach that a multimedia document is generated as part of reproducing the paper document via a document reproduction system in fig. 1, 1A, the abstract and col. 3 lines 50-54. Russell integrates embedded hyperlinks pointing to internet resources, which could be audio or video clips, into a paper document. It would have been obvious to have combined Russell and Gormish into Covington to have created the claimed invention. It would have been obvious to have used Russell to have taught one of ordinary skill in the art at the time of the invention how to have created a paper instance of the multimedia annotated document created by Covington. Gormish would have additionally taught one of ordinary skill in the art at the time of the invention how <sup>to</sup> encode different kinds of digital

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communications other than URLs which could have then been embedded into the multimedia annotated document and then produced a paper instance.

**Regarding independent claim 37**, Covington teaches creating a document to be used with a multimedia annotation in col. 2 lines 39-41 and creating a multimedia annotation representing at least one of an audio sound and a video clip in col. 2 lines 49-50. Covington also discloses storing an image of the document and the multimedia annotation in col. 4 lines 8-11 and combining the document and the multimedia annotation to form a multimedia document in col. 2 lines 52-55. What Covington does not teach is that the annotated document may be paper. Gormish does teach adding digital data, which could be annotations, into a paper document in col. 2 lines 8-40 and col. 3 lines 7-25.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gormish into Covington to create the claimed invention. It would have been obvious and desirable to use the ability to place digitally encoded data onto a paper document taught by Gormish and use the said ability to implement the annotation computer system of Covington so that the user could have had increased freedom to read the document in either paper form or electronic form.

Covington does not teach that a multimedia document is generated as part of reproducing the paper document via a document reproduction system. Russell does teach that a multimedia document is generated as part of reproducing the paper document via a document reproduction system in fig. 1, 1A, the abstract and col. 3 lines 50-54. Russell integrates embedded hyperlinks pointing to internet resources, which could be audio or video clips, into a paper document. It would have been obvious to have combined Russell and Gormish into Covington to have created

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the claimed invention. It would have been obvious to have used Russell to have taught one of ordinary skill in the art at the time of the invention how to have created a paper instance of the multimedia annotated document created by Covington. Gormish would have additionally taught one of ordinary skill in the art at the time of the invention how <sup>to</sup> encode different kinds of digital communications other than URLs which could have then been embedded into the multimedia annotated document and then produced a paper instance.

**Regarding dependent claims 2, 14, and 26,** Covington does not teach a multimedia annotation represented as a bar code printed on a multimedia document. Gormish does teach a multimedia annotation represented as a bar code printed on a multimedia document in col. 1 lines 45-66 and also discloses a more advanced form of digital representation on paper in Fig. 2.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gormish into Covington to create the invention as claimed. It would have been obvious and desirable to use a bar code to represent the multimedia annotation on the multimedia document because bar code scanners were well known and inexpensive and would have made the invention economically attractive for interpreting the multimedia data.

**Regarding dependent claims 3, 15, and 27,** Covington teaches a multimedia annotation which encodes an audio sound in the abstract.

**Regarding dependent claims 4, 16, 28, and 40,** Covington teaches a location indicator associated with the multimedia annotation is placed on the first multimedia document, wherein the location indicator indicates where the multimedia annotation can be retrieved and played in col. 2 lines 39-55.



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**Regarding dependent claims 5, 17, 29, and 41,** Covington does not teach a location indicator which is a Uniform Resource Locator in an encrypted form. Russell does teach a location indicator which is a Uniform Resource Locator in an encrypted form in fig. 1, 1A, the abstract and col. 3 lines 50-54.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Russell and Gormish into Covington to have created the claimed invention. It would have been obvious and desirable to use a URL link as the location indicator because this would make the invention compatible with the internet, which would have been a great advantage resulting in extensive compatibility and ease of storing the multimedia files.

**Regarding dependent claims 7, 19, and 31,** Covington does not teach that the multimedia document is a paper document. Gormish does teach adding digital data into a paper document which could be the combined multimedia document in col. 2 lines 8-40 and col. 3 lines 7-25.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gormish into Covington to create the claimed invention. It would have been obvious and desirable to use the paper document taught by Gormish and use said document to implement the multimedia document of Covington so that the user could have had increased freedom to read the document in either paper form or electronic form.

**Regarding dependent claims 8, 20, and 32,** Covington teaches combining the image of the document and the multimedia annotation to form a compound multimedia document in col. 2 lines 53-55. Covington also teaches storing the image of the document and multimedia annotation in col. 4 lines 8-11.

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What Covington does not explicitly teach is generating an image of the paper document, the image of the paper document being unconsciously captured during the reproduction of the paper document without user intervention. Russell teaches reproducing a paper document from which an image also exists in fig. 1, 1A, the abstract and col. 3 lines 50-54. It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined Russell and Gormish into Covington to have created the claimed invention.

It would have been obvious and desirable to one of ordinary skill in the art at the time the invention was made to have simultaneously maintained both a paper version of the multimedia annotated document and an electronic image version of the multimedia annotated document so that the user would have could have had increased freedom to read the document in either paper form or electronic form.

**Regarding dependent claims 9, 21, and 33,** Covington does not teach a location indicator which is a Uniform Resource Locator printed on a multimedia document. Russell does teach a location indicator which is a Uniform Resource Locator printed on a multimedia document in fig. 1, 1A, the abstract and col. 3 lines 50-54.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Russell and Gormish into Covington to have created the claimed invention. It would have been obvious and desirable to use a URL link as the location indicator because this would make the invention compatible with the internet, which would have been a great advantage resulting in extensive compatibility and ease of storing the multimedia files.

**Regarding dependent claims 10, 22, and 34,** Covington does not teach a location indicator represented as a bar code printed on a multimedia document. Gormish does teach a

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location indicator represented as a bar code printed on a multimedia document in col. 1 lines 45-66 and also discloses a more advanced form of digital representation on paper in Fig. 2. Russell also teaches a location indicator represented as a bar code printed on a multimedia document in fig. 1, 1A, the abstract and col. 3 lines 50-54.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Russell and Gormish into Covington to have created the invention as claimed. It would have been obvious and desirable to have used a bar code to represent the location indicator on the multimedia document because bar code scanners were well known and inexpensive and would have made the invention economically attractive for interpreting the multimedia data.

**Regarding dependent claim 38,** Covington teaches creating a multimedia annotation for a document and combining the document with the multimedia annotation to form a multimedia document in col. 2 lines 39-41. What Covington does not teach is that the annotated document may be paper. Gormish does teach adding digital data into a paper document in col. 2 lines 8-40 and col. 3 lines 7-25.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gormish into Covington to create the claimed invention. It would have been obvious and desirable to use the ability to place digitally encoded data onto a paper document taught by Gormish and use the said ability to implement the annotation method of Covington so that the user could have had increased freedom to read the document in either paper form or electronic form.

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**Regarding dependent claim 39**, Covington does not teach a multimedia annotation represented as a bar code printed on a multimedia document. Gormish does teach a multimedia annotation represented as a bar code printed on a multimedia document in col. 1 lines 45-66 and also discloses a more advanced form or digital representation on paper in Fig. 2.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gormish into Covington to create the invention as claimed. It would have been obvious and desirable to use a bar code to represent the multimedia annotation on the multimedia document because bar code scanners were well known and inexpensive and would have made the invention economically attractive for interpreting the multimedia data.

**5. Claims 11-12, 23-24, 35-36, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Covington et al. (hereafter referred to as Covington), US 5,524,193 published 06/04/1996 in view of Gormish et al. (hereafter referred to as Gormish), US 5,337,362 published 08/09/1994 and Russell et al. (hereafter referred to as Russell), US 5,905,248 published 5/18/1999 as applied to claim 8, 20, 32, and 38 above, and further in view of Halliday et al. (hereafter referred to as Halliday), US 5,880,740 published 3/9/1999.**

**Regarding dependent claims 11, 23, and 35**, Covington does not teach sending a multimedia document to a recipient by electronic mail. Halliday does teach sending a multimedia document to a recipient by electronic mail in col. 8 lines 5-28.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Halliday into Covington in view of Gormish and Russell to have created the claimed invention. It would have been obvious and desirable to send the electronic

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multimedia document to a recipient as a part of reproducing the paper document via the document reproduction system in the form of an electronic mail attachment so that the nature of the multimedia annotations be retained. One of ordinary skill in the art would have known how to set up the system to automatically send the electronic multimedia document as an attachment based on the paper document reproduction cue.

**Regarding dependent claims 12, 24, and 36,** Covington does not teach a recipient receiving an image of a paper document and a multimedia annotation in the form of a Multipurpose Internet Mail Extension (MIME). Halliday does teach a recipient receiving an image of a paper document and a multimedia annotation in the form of a Multipurpose Internet Mail Extension (MIME) in col. 8 lines 5-28.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Halliday into Covington in view of Gormish and Russell to have created the claimed invention. It would have been obvious and desirable to send the electronic multimedia document to a recipient in the form of an electronic mail attachment so that the nature of the multimedia annotations be retained. One of ordinary skill in the art would have known to send multimedia files as attachments in electronic mail.

**Regarding dependent claim 43,** Covington does not teach sending the electronic multimedia document to a recipient, wherein the recipient receives the electronic multimedia document in the form of an attachment to an electronic mail. Halliday does teach sending the electronic multimedia document to a recipient, wherein the recipient receives the electronic multimedia document in the form of an attachment to an electronic mail in col. 8 lines 5-28.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Halliday into Covington in view of Gormish and Russell to have created the claimed invention. It would have been obvious and desirable to send the electronic multimedia document to a recipient as a part of reproducing the paper document via the document reproduction system in the form of an electronic mail attachment so that the nature of the multimedia annotations be retained. One of ordinary skill in the art would have known how to set up the system to automatically send the electronic multimedia document as an attachment based on the paper document reproduction cue.

***Response to Arguments***

6. Applicant's arguments, see page 11 lines 7-13, filed 1/23/2004, with respect to the rejection of amended claim 37 under 35 U.S.C. 102(b) as being anticipated by Covington et al., US 5,524,193 published 06/04/1996 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made under 35 U.S.C. 103(a) as being unpatentable over Covington et al., US 5,524,193 published 6/4/1996 in view of Gormish et al. , US 5,337,362 published 8/9/1994 and Russell et al., US 5,905,248 published 5/18/1999. Russell teaches producing a paper document containing bar-coded URLs which may point to various multimedia resources available via the internet. The Examiner believes Russell provides the link between Covington and Gormish to render the claimed invention obvious.

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7. Applicant's arguments filed 1/23/2004 have been fully considered but they are not persuasive. The Examiner has additionally cited the reference of Russell in view of Applicant's amended claims. Regarding Applicant's argument in pages 12-13 that neither Covington nor Gormish individually or in combination discloses or suggests the limitations of the independent claims 1, 13, 25, and 37, the Examiner believes that the combination of Covington, Gormish and Russell render the claimed invention obvious. Covington teaches a embedding and linking to multimedia annotations within an electronic document, which may be one of at least an audio clip or a video clip. Gormish teaches placing digital data and digital communications on a paper document.

To one of ordinary skill in the art at the time of the invention, Russell brings these together by teaching creating a paper instance of an electronic document which contains embedded barcode links of Universal Resource Locators, which may point to multimedia files such as audio clips and video clips. The barcodes embedded throughout the document in Russell may be scanned by a computer system and an information transaction is then initiated. The information specified by the URL barcode on the paper document is presented to the user on the computer system. The Examiner believes the combination of Covington, Gormish, and Russell by one of ordinary skill in the art at the time of the invention renders the claimed invention obvious.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cragun et al., US 5,804,803 published 9/8/1998 discloses scanning and translating a

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printed code into a URL that specifies the location of information that is relevant to the object and then retrieving and communicating the information to the user. Shih et al., US 6,674,923 B1 filed 3/28/2000 discloses locating and accessing digitally stored images from a hard copy print.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Smith whose telephone number is 703-305-5931. The examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 703-305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PJS  
March 23, 2004

  
**JOSEPH FEILD**  
**SUPERVISORY PATENT EXAMINER**